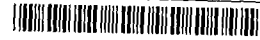


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



Pramil, S.R.L. (Esapharma)

Petitioner,

vs.

Michel Farah

Registrant

08-30-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #58

Cancellation No. 32,341

**REGISTRANT'S RESPONSE TO PETITIONER'S  
MOTION TO QUASH NOTICE OF TAKING DEPOSITION,  
MOTION TO COMPEL AND FOR EXTENSION OF DEADLINES**

COMES NOW the Registrant, Michel Farah, ("Registrant"), and responds to the Motion to Quash Notice of Taking Deposition filed by Petitioner's Pramil S.R.L. (Esapharma) ("Petitioner").

Petitioner's Motion should be denied because Petitioner both misapplies clear Board rules, and seeks to mislead this Board as to the factual circumstances surrounding the service of the Notice of Deposition which Petitioner seeks to quash.

02 SEP - 4  
FTHB: 44  
TRADEMARK TRIAL AND APPEAL BOARD

**I. PETITIONER'S REQUEST IS NOT AUTHORIZED UNDER  
APPLICABLE BOARD RULES.**

Registrant has noticed a deposition of Petitioner to be taken by written question. This procedure was required since Petitioner is a foreign company, 37 C.F.R. §§2.120(c); 2.124, and the Board rejected Registrant's Motion to Take Oral Deposition of Petitioner. The Notice of Deposition has already been filed with the Board, (without attached written questions), and served on opposing

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counsel, (with attached written questions) pursuant to Board Rules, 37 C.F.R. §2.124(b)(2), and is therefore of record.

Petitioner's primary complaint is that the Notice of Deposition does not provide a place, date or "specific individual" before whom it is to be taken. (Motion, p. 2). However, Board rules do not so require. Rather, the notice need only

"state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more person to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure." 37 C.F.R. §2.124(b)(2).

Every notice . . . shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken." 37 C.F.R. §2.124(c).

Registrant's Notice of Deposition complies in every detail with these requirements. Nowhere in these provisions is a "specific individual" before whom the deposition is to be taken required to be named, nor a specific location or date.

Petitioner cites Fed.R.Civ.P. 31(a)(3)(2) as authority for its Motion to Quash. This is inappropriate, since the above cited Board rules, and not Federal Rule 31(a)(3)(2) apply in the instant case. Specifically, 37 C.F.R. §2.120 provides that the Federal Rules apply only "except as otherwise provided in this section," i.e. except as otherwise provided in Section 2.120. 37 C.F.R. §2.120(a). In turn, Section 2.120 specifically states that

discovery depositions in foreign countries are to "be taken in the manner prescribed by §2.124." 37 C.F.R. §2.120(c)(1). Thus, Board Rule 2.124, cited above, and not Federal Rule 31(a)(3)(2), is the applicable procedural rule as to foreign depositions. 37 C.F.R. §§2.120(a), (c)(1) & 2.124.<sup>1</sup>

Moreover, it is entirely logical, in the context of a foreign, deposition by written question, to begin the deposition process prior to designating a specific date, location and individual before whom the deposition is to be taken. The written deposition procedure requires, first, the exchange of and finalization of lists of written questions and objections between counsel. The questions are then mailed to the officer designated in the notice of deposition, who thereafter individually arranges for the deposition to take place. See, 37 C.F.R. §2.124(e).

Under this procedure, no specific time can be set at the outset because until the exchange of written questions is actually complete, it is impossible to predict exactly how long this process will take, and when the finalized questions of both parties will be completed. Moreover, the specific individual officer before whom the deposition is to be taken need not be named at the outset, since the deposition questions will be forwarded to that individual

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<sup>1</sup> In fact, while Fed.R.Civ.P. 31(a)(3)(2) does add the requirement of an "address" of the officer before whom the deposition will be taken, it does not require either a specific time or individual before whom the deposition will be taken.

and served on all parties thereafter, specifically identifying that individual at that time.

In fact, in the instant case, the requested specificity is simply not practical, or, in all likelihood, even possible at this early stage of the written deposition process.

Under Board Rules, a deposition must be taken before an individual so authorized under Fed.R.Civ.P. 28. 37 C.F.R. §2.124. Federal Rule 28, in turn, provides that, as to depositions in foreign countries:

"Depositions may be taken in a foreign country (1) pursuant to any applicable treaty or convention, or (2) pursuant to a letter of request (whether or not captioned a letter rogatory), or (3) on notice before a person authorized to administer oaths in the place where the examination is held, either by the law thereof or by the law of the United States, or (4) before a person commissioned by the court, and a person so commissioned shall have the power by virtue of the commission to administer any necessary oaths and take testimony. . . . A notice or commission may designate the person before whom the deposition is to be taken either by name or descriptive title." Fed.R.Civ.P. 28(b) (emphasis added).

In Italy, the location for the noticed deposition, for example, the undersigned has been advised by various Italian counsel that there are no persons generally authorized by foreign law to administer an oath in a deposition-like setting absent judicial involvement of the Italian courts. Thus, it would appear that the Hague Convention on the Taking of Evidence Abroad In Civil or Commercial Matters provides the applicable procedural rules, absent

stipulation by the parties as to the deposition procedures.<sup>2</sup> Under the Hague Convention, a letter of request is first required to be approved by the appropriate United States Court and the appropriate foreign authority before the deposition can even be scheduled. Hague Convention, Chapter I - Letters of Request. Obviously, in such a situation, the Notice of Written deposition cannot provide a specific individual, time and location for the deposition to take place until the Letter or Request is approved.

Similarly, under the Hague Convention, a Commissioner can be appointed by a United States Court, and approved by the foreign authority. Hague Convention, Article 17. Again, at the initial deposition notice stage, it is not possible to specifically identify the commissioner, time or location of the deposition, since approval has not yet been obtained.

The Hague Convention also provides that a U.S. consular agent may take evidence of a foreign national. Hague Convention, Article 16. However, again, approval of the Italian Court's is required. Id.; Italian instrument of ratification, June 22, 1982).<sup>3</sup> Moreover, to date, the undersigned has been unable to secure a commitment from appropriate Italian consulate in Northern Italy to

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<sup>2</sup> Hague Convention reproduced as note to 28 U.S.C. §1781 in the West Group handbook "Federal Civil Judicial Procedure and Rules," 2002.

<sup>3</sup> Also reproduced, in pertinent part, in the West Group's "Federal Judicial Procedure and Rules," 2002, as a note to the reproduced Hague Convention.

participate in these proceedings. The undersigned was advised that that consulate was "getting out of the deposition business" due to under staffing (though, apparently, the key decision making personnel are out of the office and will not be back until September of this year).

In conclusion, the applicable rules do not require the specificity sought by Petitioner in a Notice of Written Deposition; and, the real life practicalities would appear to all but preclude the inclusion of the detailed information sought at the time of the initial notice of deposition.

## **II. PETITIONER'S MOTION IS MISLEADING, AT BEST.**

Petitioner complains that "petitioner is at a loss to know as to when and where this deposition is to be taken." (Motion, p. 2). Petitioner also claims that "it is not known when or if such Notice was filed with the Board." (Motion, p. 1). Finally, Petitioner complains that the Notice "refers to an incorrect statutory basis." (Motion, p. 2). Each and every one of these assertions is misleading at best.

During a lengthy conversation between the undersigned and opposing counsel pertaining to this deposition, these issues were either never raised by opposing counsel, or were discussed in detail. As set forth in the attached correspondence, (Exhibit A), the undersigned clearly offered to work with opposing counsel in

scheduling the deposition at a mutually convenient time and location. In response, however, without further consulting the undersigned, the instant Motion to Quash was filed, purely as a delay tactic.

### **III. MOTION TO COMPEL/FOR EXTENSION OF DEADLINES.**

If a motion for a protective order, such as Petitioner has filed, is denied in whole or part, the Board may order that the party provide the discovery, or that the discovery be permitted. 37 C.F.R. §2.120(f). Accordingly, Registrant requests that Petitioner be required to serve its objections and cross-questions under 37 C.F.R. §2.124 immediately, and further participate in the exchange of questions/objections process under 37 C.F.R. §2.124, or forfeit its right to do so.

Moreover, Registrant requests an adequate amount of time to arrange for a date, location and specific officer before whom the deposition may take place, including sufficient time to obtain a letter of request or appointment of a commissioner, either of which require approval of both the Board, and the Italian authorities. Specifically, Registrant requests an additional thirty (30) days in which to prepare and seek the letter of request or appointment of commissioner from this Board. Thereafter, Registrant further requests that the pre-trial and trial deadlines be extended until sixty (60) days following the actual deposition of Petitioner.

See, 37 C.F.R. §2.124(d)(2) ("Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.") Respondent does not seek suspension of these proceedings, since it has subpoenaed three non-party witnesses for deposition in early October of this year, and any suspension would interfere with or delay these United States depositions.

Respectfully submitted,

Dated: August 26, 2002

By:



John Cyril Malloy, III  
Florida Bar No. 964,220  
Andrew W. Ransom  
Florida Bar No. 964,344  
MALLOY & MALLOY, P.A.  
2800 S.W. 3rd Avenue  
Miami, Florida 33129  
Telephone: (305) 858-8000  
Facsimile: (305) 858-0008



**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing AGREED MOTION FOR EXTENSION OF TIME was served on Donald L. Dennison, Esq, Dennison, Scheiner, Schultz and Wakeman, 1745 Jefferson Davis Highway, Suite 612, Arlington, Virginia 22202 by United States mail, postage pre-paid this 26<sup>th</sup> day of August, 2002.

Respectfully submitted,

By: Andrew W. Ransom  
Andrew W. Ransom  
Florida Bar No. 964,344

**CERTIFICATE OF MAILING**

I HEREBY CERTIFY that an original <sup>was</sup> ~~and two copies were~~ deposited by United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, Attn: T.T.A.B., "Box TTAB", 2900 Crystal Drive, Arlington, Virginia 22202-3513, this 26<sup>th</sup> day of August, 2002.

Respectfully submitted,

By: Andrew W. Ransom  
Andrew W. Ransom  
Florida Bar No. 964,344

## **EXHIBIT A**

# Malloy & Malloy, P.A.

"Since 1959"  
Registered Patent Attorneys  
Trial and Appellate Counsel  
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## Patent, Trademark & Copyright Law

Ft. Lauderdale Office  
2101 West Commercial Blvd.  
Reply to: Miami Office  
Broward (954) 525-9611  
FLORIDA (800) 337-7239

August 9, 2002

VIA FACSIMILE & MAIL  
(703) 412 - 1161

Donald L. Dennison, Esq.  
Dennison, Scheiner, Schultz and Wakeman  
1745 Jefferson Davis Highway, Suite 612  
Arlington, VA 22202

Re: Pramil S.R.L (Esapharma) v. Michel Farah  
Our Ref.: 5.467.01

Dear Donald:

This shall serve to confirm our telephone conference of today. During that telephone conference, you indicated that you believed our Notice of Taking Deposition of your client by written question was defective because it did not specify a date or location for the taking of the deposition. We have again reviewed the rules in this regard, and see no such requirement. We do note a typographical error in our Notice, in that the references to "35 U.S.C." should state "37 C.F.R.," such that the referenced provisions should read that the deposition shall take place pursuant to "37 C.F.R. §2.120(c) and 2.124." With this clarification, the procedures with regard to service of cross-questions, and objections should go forward.

You indicated that you would have to review the rules as to your believed deficiency in the Notice of Deposition. If, after your review of the rules, you have a specific objection to the manner of notice, with some supporting law, we would be happy to review your objection. However, since deposition by written question is a fairly rare occurrence, and the rules provide little guidance on these issues, we suggest that it is a more efficient use of everyone's time to simply work out the date and location of the deposition among counsel, rather than delay discovery over this matter.

In the meantime, we will seek to identify a court reporter for the purposes of taking the deposition in or near Melzo (Milan) Italy, as this is the stated address of Petitioner in the Petition to cancel, and you were unable during our telephone conference to provide any other address. When we have confirmed the court reporter, hopefully by next Monday or Tuesday, we will so advise you.

As to the specific date of the deposition, it will be


difficult to determine since it is dependent upon the outcome of and timing of the procedure set forth in 37 C.F.R. §2.124. However, we suggest that you provide us with times during the months of September and October in which your client will be available in Italy. We will make our client available for deposition thereafter.

Also, at this time, please advise as to whether we will need an interpreter, and, if so, for what language. If so needed, it is our intent to have an interpreter present to interpret the questions into Italian (or other language as necessary), and the responses back into English for the Court reporter to record.

As to other discovery matters, we will make the changes agreed upon to the stipulated protective order, and forward that document to your attention shortly. The parties can then exchange true and accurate copies of documentation. We also look forward to receiving the signed, sworn interrogatory responses pursuant to our discussion.

Finally, as to depositions of Michael and Jacob Aini, and ICE Marketing Corp., you have advised that you are not able to accept a subpoena on their behalf. As to Jacob Aini, it is questionable whether a subpoena is necessary, as he is apparently signing the Interrogatories as a representative on behalf of Petitioner. At any rate, given the current discovery cut-off in this matter, our intention is to notice these depositions for early October, with the understanding that to the extent possible, we will consider consolidating the depositions with those in the pending New York federal court action, or extending the discovery deadline as necessary.

Very truly yours,

  
Andrew W. Ransom  
For the Firm

AWR/lr

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\* TRANS [ MESSAGE CONFIRMATION REPORT ]  
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TEL : 3058580008  
DATE: 08/09 14:19

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**Malloy & Malloy, P.A.** **FAX COVER SHEET**  
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DATE: August 9, 2002  
TO: Donald L. Dennison, Esq.  
OF: Dennison, Scheiner et al.  
FAX NO.: 703-412-1161  
FROM: Andrew W. Ransom, Esq.  
RE: **Framil S.R.L. v. Michel Farah**  
Our Ref.: 5.467.01  
NO. OF PAGES, INCLUDING THIS FAX COVER SHEET: 3

**MESSAGE :**

**Malloy &  
Malloy, P.A.**

**FAX COVER SHEET**

**Patent, Trademark & Copyright Law**

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NO. OF PAGES, INCLUDING THIS FAX COVER SHEET: 3

**MESSAGE:**